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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,207	10/10/2003	Stephen Gold	200309331-1	2882

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EXAMINER
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DILLON, SAMUEL A

ART UNIT	PAPER NUMBER
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2185

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/684,207

**Applicant(s)**

GOLD ET AL.

**Examiner**

Sam Dillon

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/10/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Examiner acknowledges the applicant's submission of the amendment dated January 8, 2007. Per the amendment, Claims 10, 16, 20 and 23 have been amended.
2. The instant application having Application No. 10/684,207 has a total of 23 claims pending in the application; there are 6 independent claims and 17 dependent claims, all of which are ready for examination by the examiner.

#### I. RESPONSE TO AMENDMENT(S) / ARGUMENT(S)

3. In response to the amendment, the 35 U.S.C. 112 second paragraph rejections of Claims 20-22 as stated in the previous action are withdrawn.
4. Applicant's arguments filed January 8, 2007 have been fully considered but they are not persuasive. Accordingly, the rejections of Claims 1-9, 13-15 and 19-22 are **upheld**. Additionally, further search and consideration has been given to Claims 10-12, 16-18 and 23, all of which now stand rejected.

5. Regarding Claims 1, 13 and 19, the Applicant contends that Vines does not disclose **receiving a list of media to be loaded into a plurality of backup devices**. More specifically, the Applicant contends that **a file is not a list of media**. The Examiner respectfully disagrees.

A list is interpreted as a data structure containing either zero or more elements or identifiers representing zero or more elements, and media as per Merriam Webster (<http://m-w.com/dictionary/media>): "*a medium of conveyance*". As such, a list of media is a data structure containing either *a)* zero or more mediums of conveyance, or *b)* zero or more identifiers of mediums of conveyance. Accordingly, the Examiner respectfully asserts that a file can be considered in itself a list of a single medium of conveyance.

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Regarding **Claims 1, 13 and 19**, the Applicant contends that Vines does not disclose **ordering the list by physical location of the backup devices**. More specifically, the Applicant claims that **a drive is not a backup device** and also that **no such ordering takes place**. The Examiner respectfully disagrees.

Regarding a drive being a backup device, the Examiner interprets a '*backup device*' to be exactly that: a device that is capable of backing up data. More specifically, by the nature of saving a file to a disk the user is making a backup of the file.

Regarding the ordering by physical location, the Examiner notes that as interpreted in the previous action, the list of media to be ordered consists of a single file. As such, ordering by physical location in ascending order would amount to the same operation as ordering by physical location in descending order. Further and more pointedly, a list of a single object is inherently ordered by any measure or order, and as such is considered ordered by the physical location of the backup devices. Whether Vines explicitly discloses a physical location of the drives is immaterial; drives inherently have a physical location.

Accordingly, the Examiner respectfully asserts that Vines does disclose ordering the list by physical location of the back up devices.

7. Regarding all other Claims not specifically traversed above and whose rejections were upheld, the Applicant contends that the listed claims are allowable by virtue of their dependence on other allowable claims. As this dependence is the sole rationale put forth for the allowability of said dependent claims, the Applicant is directed to the Examiner's remarks above. Additionally, any other arguments the Applicant made that were not specifically addressed in

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this Office Action appeared to directly rely on an argument presented elsewhere in the Applicant's response that was traversed or found persuasive above.

## II. REJECTIONS BASED ON PRIOR ART

### *Claim Rejections - 35 USC ' 102 - Vines*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-9, 13-15 and 19-22** are rejected under 35 U.S.C. 102(b) as being anticipated by Vines ("*How to save your files and your sanity*").

10. As per **Claims 1, 13 and 19**, but more specifically to Claim 13, Vines discloses a system comprising:

a planner (*program, section "The Save dialog box", line 1*) to receive a list of media (*file, section "Computing Rule #1", line 1*) to be loaded into a plurality of backup devices (*drives, section "Save it" line 5*) and to order the list by physical location of the backup devices (*the list is length 1, so is inherently ordered by any measure of ordering*); and

a user interface, communicatively coupled to the planner, to present the ordered list to a user (*section "The Save dialog box"*).

11. As per **Claims 2, 14 and 20**, but more specifically to Claim 13, Vines discloses the system of Claim 13, further comprising

a configuration agent, communicatively coupled to said planner, to configure a physical location for each of the backup devices (*as the drives are assigned logical drive*

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*letters, it is inherently implied that each of the drives has been assigned a physical location by a machine or user, section "Save it").*

12. As per **Claim 3**, Vines discloses the method of **Claim 2**, wherein configuring the physical location comprises

obtaining information for one or more site locations and assigning each of the backup devices to one of the site locations (*inherent in a computer having a drive is a user or technician installing the drive to a computer or to storage means, the means fulfilling the limitation of the site location*).

13. As per **Claim 4**, Vines discloses the method of **Claim 3**, wherein configuring the physical location further comprises:

obtaining information for one or more data centers, each of the data centers associated with one of the site locations; and assigning each of the backup devices to one of the data centers (*a hard drive in a computer is a backup device assigned to a "data center", i.e. the collection of all hard drives in that computer*).

14. As per **Claims 5 and 21**, but more specifically to **Claim 5**, Vines discloses the method of **Claim 2**, wherein configuring the physical location comprises

assigning a grid location in a data center to at least one of the backup devices (*a grid location is interpreted as an address, which is inherently implied if the computer of Vines has multiple drives and is able to differentiate between them, section "Save it").*

15. As per **Claims 6 and 22**, but more specifically to **Claim 6**, Vines discloses the method of **Claim 5**, wherein configuring the physical location further comprises

assigning an order number to each of the grid locations (*any address the grid locations is inherently implied to be numerical in nature as it is realized in a computing system*).

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16. As per **Claim 7**, Vines discloses the method of **Claim 5**, wherein assigning a grid location comprises for at least one of the backup devices,
- automatically assigning, to the backup device, a grid location of a system attached to the backup device (*an address of the backup device is shared by pieces of the backup device*).
17. As per **Claim 8**, Vines discloses the method of **Claim 1**, wherein
- ordering the list comprises ordering the list of media by an order number associated with each of the backup devices (*the drives are inherently ordered by the drive letter, section "Save it"*).
18. As per **Claims 9 and 15**, but more specifically to **Claim 15**, Vines discloses the system of **Claim 13**, wherein said user interface is further to
- receive a list of media (*selection of where to save file, section "Save it"*) to be used for one or more future executions of one or more backup jobs (*saving of a file, section "Save it"*) associated with the backup device and to transmit the list to said planner (*clicking OK, section "Save it"*).

**Claim Rejections - 35 USC ' 103**

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 10-12, 16-18 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vines (*"How to save your files and your sanity"*) in view of Kanai et al. (*US Patent Publication Number 2002/0152181 A1*).

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21. As per **Claims 10, 16 and 23**, but more specifically to **Claim 10**, **Vines** discloses the method of **Claim 9**, but does not disclose that before receiving the list of media, calculating a required number of scratch media needed for the future executions and presenting the required number of scratch media to the user.

**Kanai** discloses calculating a required number of media needed for the future executions and presenting the required number of scratch media to the user (*paragraphs 18 and 19*).

Vines and Kanai are analogous art in that they have to do with user management of storing files. At the time of the invention it would have been obvious to a person having ordinary skill in the art to save Vines' file to Kanai's rented storage.

The motivation for doing so would have been that rented storage allows users to be released from the burden of maintenance of storage and thereby have less responsibility of administration (*Kanai, paragraph 5*). Therefore, it would have been obvious to combine Vines' file saving method with Kanai's rented storage for the benefit of easier administration, to obtain the inventions of **Claims 10, 16 and 23**.

22. As per **Claim 11 and 17**, but more specifically to **Claim 11**, **Vines** and **Kanai** disclose the method of **Claim 10**, wherein calculating comprises:

obtaining backup job information from one or more backup applications for the backup jobs (*Kanai, history of usage, paragraph 18*); and

using the backup job information to calculate the required number of scratch media needed for the future executions (*Kanai, paragraph 18*).

23. As per **Claims 12 and 18**, but more specifically to **Claim 12**, **Vines** and **Kanai** disclose the method of **Claim 10**, wherein calculating the required number of scratch media comprises

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for at least one of the future executions, dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job (*Kanai, figure 17*).

## **IX. CLOSING COMMENTS**

### **a. STATUS OF CLAIMS IN THE APPLICATION**

24. The following is a summary of the treatment and status of all claims in the application as recommended by M.P.E.P. ' 707.07(i):

#### **a(1). CLAIMS REJECTED IN THE APPLICATION**

25. Per the instant office action, Claims 1-23 have received an action on the merits.

### **b. DIRECTION OF FUTURE CORRESPONDENCES**

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Dillon whose telephone number is 571- 272-8010. The examiner can normally be reached on 9:30-6:00.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sanjiv Shah can be reached on 571-272-4098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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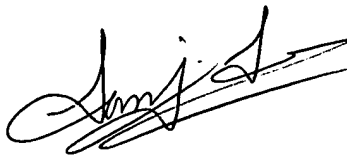
**IMPORTANT NOTE**

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SAD

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